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UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20503
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JAN 5 2001

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 17, 18 and 49 of the morning section and questions 10, 16, 23, 28, 33, 44 and 48 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On July 19, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning questions 17, 18 and 49 and afternoon questions 10, 16, 23, 28, 33, 44 and 48. Petitioner's arguments for these questions are addressed individually below.

Morning question 17 reads as follows:

17. Smith invented a laminate. In a patent application, Smith most broadly disclosed the laminate as comprising a transparent protective layer in continuous, direct contact with a light-sensitive layer without any intermediate layer between the transparent protective layer and the light-sensitive layer. The prior art published two years before the effective filing date of Smith's application included a laminate containing a transparent protective layer and a light-sensitive layer held together by an intermediate adhesive layer. Which of the following is a proper claim that would overcome a 35 U.S.C. § 102 rejection based on the prior art?

- (A) 1. A laminate comprising a transparent protective layer and a light-sensitive layer.
- (B) 1. A laminate comprising a transparent protective layer and a light-sensitive layer which is in continuous and direct contact with the transparent protective layer.
- (C) 1. A laminate comprising a transparent protective layer and a light-sensitive layer, but not including an adhesive layer.
- (D) (A) and (B).
- (E) (B) and (C).

The model answer is choice (E).

(E) is correct because (B) and (C) are correct. (A) does not overcome the prior art because the broad "comprising" language permits the laminate to include additional layers, such as an adhesive layer. MPEP 2111.03. (B) overcomes a 35 U.S.C. § 102 rejection because the claim requires a light-sensitive layer to be in continuous and direct contact with the transparent protective layer, whereas the prior art interposes an adhesive layer between the light-sensitive layer and transparent protective layer. (C) also avoids the prior art by using a negative limitation to particularly point out and distinctly claim that Smith does not claim any laminate including an adhesive layer. MPEP 2173.05(i).

Petitioner argues that answer (B) alone is correct. Petitioner contends that answer (C) is an improper negative limitation claim and should be rejected for undue breadth and indefiniteness because the claim fails to specify where the missing adhesive layer would have been. Petitioner concludes that answer (C) is incorrect and maintains that answer (E) is incorrect for the same reason.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that answer (C) is an improper negative limitation claim, the answer specifically states that the laminate comprises a transparent protective layer and a light-sensitive layer but not including an adhesive layer. MPEP 2173.05(i) indicates that there is nothing inherently wrong with negative limitations. In this fact pattern, the absence of an adhesive layer is fully supported by the specification and therefore does not attempt to merely exclude what was not invented, and because the layer is absent, its location is irrelevant. As to petitioner's argument that the disclosure does not support the negative limitation, the question specifically states that Smith most broadly disclosed the laminate as comprising a transparent protective layer in continuous, direct contact with a light-sensitive layer **without any intermediate layer between the transparent protective layer and the light-sensitive layer**. Accordingly, answer (C) is a proper claim, rendering answer (C) correct. The statement in answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 18 reads as follows:

18. Which of the following is NOT a policy underlying the public use bar of 35 U.S.C. § 102(b)?
- (A) Discouraging the removal, from the public domain, of inventions that the public reasonably has come to believe are freely available.
 - (B) Favoring the prompt and widespread disclosure of inventions.
 - (C) Allowing the inventor(s) a reasonable amount of time following sales activity to determine the potential economic value of a patent.
 - (D) Increasing the economic value of a patent by extending the effective term of the patent up to one year.
 - (E) Prohibiting the inventor(s) from commercially exploiting the invention for a period greater than the statutorily prescribed time.

The model answer is choice (D).

Extending patent term is not a policy underlying any section of 35 U.S.C.

§ 102. Answers (A), (B), (C) and (E) do state policies underlying the public use bar. *Lough v. Brunswick Corp.*, 86 F.3d 1113, 39 USPQ2d 1100, 1104 (Fed. Cir. 1996). "One is entitled to a patent unless, inter alia, 'the invention was . . . in public use . . . in this country, more than one year prior to the date of the application for patent in the United States.' 35 U.S.C. Section 102(b) (1994). **We have defined 'public use' as including 'any use of [the claimed] invention by a person other than the inventor who is under no limitation, restriction or obligation of secrecy to the inventor.'** In re Smith, 714 F.2d 1127, 1134, 218 USPQ 976, 983 (Fed. Cir. 1983) (citing *Egbert v. Lippmann*, 104 U.S. 333, 336 (1881)). An evaluation of a question of public use depends on 'how the totality of the circumstances of the case comports with the policies underlying the public use bar.' *Tone Bros. v. Sysco Corp.*, 28 F.3d 1192, 1198, 31 USPQ2d 1321, 1324 (Fed. Cir. 1994), cert. denied, 115 S. Ct. 1356 (1995). These policies include:

(1) discouraging the removal, from the public domain, of inventions that the public reasonably has come to believe are freely available; (2) favoring the prompt and widespread disclosure of inventions; (3) **allowing the inventor a reasonable amount of time following sales activity to determine the potential economic value of a patent**; and (4) prohibiting the inventor from commercially exploiting the invention for a period greater than the statutorily prescribed time."

Petitioner argues that (C) is correct. Petitioner contends that (C)'s reference to sales rather than use makes (C) the proper answer as not a policy. Petitioner makes no argument that answer (D) is incorrect but maintains that answer (C) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that answer (C) refers to sales instead of use and therefore is not a policy underlying the public use bar, the answer specifically states that allowing the inventor(s) a reasonable amount of time following sales activity to determine the potential economic value of a patent is not a policy underlying the public use bar. As explained in *Lough*, this is such a policy, and as defined in *Lough*, sales is an example of public use. Accordingly, allowing the inventor(s) a reasonable amount of time following sales activity to determine the potential economic value of a patent is a policy underlying the public use bar, rendering (C) incorrect. The

statement in answer (D) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 49 reads as follows:

49. Which of the following statements is NOT true?

(A) In representation of a client, a patent practitioner may not refuse a client's request that the practitioner aid or participate in conduct that the practitioner believes to be unlawful so long as there is some support for an argument that the conduct is legal.

(B) A patent practitioner may not form a partnership with a non-practitioner if any of the activities of the partnership consists of the practice of patent law before the PTO.

(C) In a patent case, a practitioner may take an interest in the patent as part or all of his or her fee.

(D) If a practitioner receives information clearly establishing that a client has, in the course of representation, perpetrated a fraud on the PTO that the client refuses or is unable to reveal, the practitioner must reveal the fraud to the PTO.

(E) A patent practitioner may not accept compensation from a friend of a client for legal services performed by the practitioner for the client, unless the client consents after full disclosure.

The model answer is choice (A).

37 C.F.R. § 10.84(b)(2) specifies that a practitioner may refuse to aid or participate in conduct the practitioner believes to be unlawful, even though there is some support for an argument that the conduct is legal. Thus, statement (A) is FALSE. Statement (B) is TRUE. 37 C.F.R. § 10.49. Statement (C) is TRUE. 37 C.F.R. § 10.64(a)(3). Statement (D) is TRUE. 37 C.F.R. § 10.85(b)(1). Statement (E) is TRUE. 37 C.F.R. § 10.68(a)(1).

Petitioner argues that (B) is also correct. Petitioner contends that patent practitioners form partnerships with non-practitioners as a matter of course. Petitioner does not offer any specific evidence of this assertion, but mentions the practice of patent attorneys in partnership with other attorneys not admitted before the USPTO as examples.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that patent practitioners form partnerships with non-practitioners as a matter of course, with the practice of patent attorneys in partnership with other attorneys not admitted before the USPTO as examples, the question specifically states that a patent practitioner may not form a partnership with a non-practitioner if any of the activities of the partnership consists of the practice of patent law before the PTO. As explained in 37 CFR 10.1(r), a practitioner includes anyone authorized to practice before the Office in any non-patent case under 5 U.S.C. 500(b) ("An individual who is a member in good standing of the bar of the highest court of a State may represent a person before an agency on filing with the agency a written declaration that he is currently qualified as provided by this subsection.") and is authorized to represent the particular person in whose behalf he acts. Therefore, the examples provided by petitioner are of patent practitioners in partnership with practitioners. Accordingly, there is no evidence that patent practitioners may form partnerships with non-practitioners, rendering the statement in answer (B) incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 10 reads as follows:

10. On December 1, 1998, Sam, attorney for the firm of Thrill and Chill, files a request for reexamination of a patent owned by his client, Hurley Corp., along with a recently discovered Russian patent which issued more than one year before the filing date of the patent. Hurley's patent contains one independent claim and nine dependent claims. The request for reexamination is granted on February 1, 1999. On June 1, 1999, an Office action issues in which the Examiner properly rejects independent claim 1 under 35 U.S.C. §§ 102 and 103 using the Russian reference and objects to the remaining claims as being dependent upon a rejected claim. Sam receives the Office action, agrees with the Examiner that claim 1 is unpatentable over the Russian patent and forwards it to his client, Hurley Corp. Hurley Corp. is undergoing financial

problems and files for bankruptcy protection with the Federal District Court. They advise Sam that they have no funds available to further prosecute the reexamination proceeding. In accordance with proper PTO practice and procedure what should Sam do?

- (A) Advise the Examiner on the telephone that the patentee has filed for bankruptcy protection, and that nothing should be done in the reexamination proceeding until the bankruptcy is settled.
- (B) Do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 is confirmed.
- (C) File a fallacious reply arguing the patentability of claim 1 in order to allow the reexamination proceeding to continue.
- (D) File a divisional reexamination proceeding whereby claims 2 through 10 will be transferred into the divisional and allowed to issue. Claim 1, still in the original reexamination proceeding, can then be appealed to the Board of Patent Appeals and Interferences at a later point in time after the bankruptcy is resolved.
- (E) Send a letter to his client Hurley Corp. advising them that unless he is paid in advance, he will take no further action in the proceeding and file no papers with the PTO.

The model answer is choice (B).

Selection (B) is correct as per MPEP §§ 2287 and 2288. As to (E), Sam must request to withdraw and obtain permission from the PTO in accordance with 37 C.F.R. § 10.40 and MPEP § 402.06. As to (A), bankruptcy will not stay a reexamination. As to (C), false representations are prohibited by the rules. As to (D), there are no divisional reexaminations.

Petitioner argues (E) is correct and (B) is incorrect. Petitioner contends that a responsible attorney would inform the applicant and (E) is the same as (B) but also informs the applicant.

Petitioner concludes that answer (E) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that it is good practice to inform the applicant, the answer (E) specifically states that the attorney advises the applicant that unless he is paid in advance, he will take no further action in the proceeding and file no papers with the PTO. Answer (E) is more than a reminder, it is a statement of intended action and Sam must request to withdraw and obtain

permission from the PTO in accordance with 37 C.F.R. § 10.40 and MPEP § 402.06. The examiner and attorney are in agreement as to the status of the claims and no amendment or response of any kind from the patent owner or attorney is required. Given that no action is required and a registered practitioner would know not to threaten to abandon the applicant absent PTO permission, the statement in answer (B) is correct and the statement in answer (E) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 16 reads as follows:

Please answer questions 16 and 17 based on the following facts. On February 15, 1999, Debbie conceived a unique system for humanely caging hunting dogs and automatically feeding them at appropriate times. Debbie told her husband, Ted, about her idea that night, and the two spent the next four months working regularly on the concept. Ted built a cage that implemented the concept on June 17, 1999, and tested it on his own dogs for a week. It worked perfectly for its intended purpose. The next day, Ted visited a family friend, Ginny, who happened to be a registered practitioner, and asked her to prepare a patent application on Debbie's behalf. Ginny declined representation, explaining that she was in the middle of trial preparation and would not be able to work on the application for at least four months. Ginny gave Ted the names of a number of qualified patent practitioners, suggesting he consider retaining one of them to promptly prepare the patent application, and explained that a delay in filing the patent application could prejudice Debbie's patent rights. Ted, however, felt uncomfortable going to a practitioner he did not know personally, and did not contact any of the individuals recommended by Ginny. After Ginny had completed her trial and was back in the office, Ted visited her on December 1, 1999. At that time Ginny agreed to represent Debbie. An application was filed in the PTO within 10 days.

On May 15, 1999, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a registered practitioner. Billie filed a patent application on June 14, 1999. Later, on July 9, 1999, Billie built a cage that implemented the concept and had fully tested it by August 11, 1999.

16. Assuming Debbie's patent application is substantively identical to Billie's patent application, which of the following statements is most correct?

- (A) Nearly simultaneous invention by Debbie and Billie is proof that the invention is obvious and precludes patentability.
- (B) Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.
- (C) Nearly simultaneous invention by Debbie and Billie may be evidence of a long-felt need for the invention.
- (D) Nearly simultaneous invention by Debbie and Billie may be evidence of commercial success of the invention.
- (E) Statements (A), (B), (C) and (D) are each incorrect.

The model answer is choice (B).

Selection (B) is correct as per *The International Glass Company, Inc. v. United States*, 159 USPQ 434 (US Cl.Ct. 1968); *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986); *Newell Cos. v. Kenney Mfg.*, 9 USPQ2d 1417 (Fed. Cir. 1988); *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 45 USPQ2d 1977 (Fed. Cir. 1998). Statement (A) is not correct because, although nearly simultaneous invention may be a factor in making an obviousness determination, it does not in itself preclude patentability. *Environmental Designs, Ltd. v. Union Oil Co.*, 218 USPQ 865 (Fed. Cir. 1983). Statements (C) and (D) are incorrect because nearly simultaneous invention bears on neither long-felt need nor commercial success. Statement (E) is incorrect because statement (B) is correct.

Petitioner argues that none of the answers is correct. Petitioner contends that the cases cited are not appropriate applications to the question in light of a purported omission in the MPEP on the examined point. Petitioner argues that the silence in the MPEP on the question of whether near simultaneous invention is evidence of level of skill is proof that the cited cases are not applicable. Petitioner concludes that answer (B) is incorrect and maintains that answer (E) is correct because it is the only answer indicating all other answers are incorrect.

Petitioner's argument has been fully considered but is not persuasive. As indicated in the instructions, the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and

procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, **unless modified by a subsequent court decision** or a notice in the *Official Gazette*. The cases cited above are clearly applicable on the issue of whether nearly contemporaneous invention is evidence of the level of skill in the art. The MPEP is merely an additional place where the existing case law is recorded, but any purported absence of case law from the MPEP in no way negates the effect of case law.

The *Merck* case stated at 380, “[t]he additional, although unnecessary, evidence of contemporaneous invention is probative of ‘the level of knowledge in the art at the time the invention was made.’ *In re Farrenkopf*, 713 F.2d 714, 720, 219 USPQ 1, 6 (Fed. Cir. 1983).” *Monarch Knitting* stated “[t]his court has noted the relevance of contemporaneous independent invention to the level of ordinary knowledge or skill in the art” at 1983, referring to *Merck*. Accordingly, nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention, rendering the statement in answer (B) correct and therefore answer (E) incorrect because (B) is correct. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 23 reads as follows:

23. In 1998, Chris invents an automobile or truck windshield wiper device that uses a transparent grid to automatically sense water drops on the windshield and wipe the window whenever a drop appears. The grid detects current variations when moisture impregnates the grid, and then activates the windshield wiper. In April 1998, Chris submitted an article for publication in *Popular Scientist* magazine disclosing the invention. The magazine edited the article to the extent

that the article, published August 1, 1998, fails to enable one of ordinary skill in the art to make the invention. On August 31, 1998, Chris offers the automobile windshield wiper device for sale to the Ajax Motor Company, leaving a sample device for use in automobiles at the Ajax plant. Chris knew his device can be used with trucks only if the sensors are modified to accommodate the larger windshields, however no such modification has been made. Without Chris' knowledge, Ajax intends to use the device on its trucks. Ajax modifies and successfully tests the device using larger sensors for trucks on a public highway on September 1, 1998. Chris files a patent application with the PTO for the basic concept for automotive windshields on August 2, 1999. On August 30, 1999, Chris realizes that Ajax modified his invention to work with trucks on September 1, 1998, and that his claims do not cover the truck embodiment. There is no basis in the application supporting a claim directed to the embodiment for trucks, but the modification would have been obvious to one of ordinary skill in the art. Chris' application has not yet issued. He comes to you, a registered practitioner, for advice on the morning of August 30, 1999 as to whether he should file a new application for his windshield wiper directed to trucks and buses. What should you advise Chris to do in accordance with proper PTO practice and procedure?

- (A) The Popular Scientist publication is a bar under 35 U.S.C. § 102(b) since it was filed over a year before the application was filed.
- (B) Chris can still file a claim in the pending application directed to windshield wipers for trucks because the modification of the sensors would have been obvious to the artisan.
- (C) Chris must file a new application on or before September 1, 1999, to avoid the testing by Ajax from becoming a statutory bar to him obtaining a second patent directed to the windshield wiper for trucks embodiment.
- (D) Chris may file a continuation-in-part application anytime before the first patent application issues in which he can disclose and claim the windshield wiper device for use on trucks and buses since a continuation-in-part is entitled to the parent filing date for everything disclosed in the continuation-in-part application.
- (E) Since the Ajax use of the device on trucks was not discovered until August 31, 1999, Chris has one year from August 31, 1999, to file a new patent application directed to use of his invention on trucks.

The model answer is choice (C).

As to answer (A), the publication in Popular Scientist was not enabling. Unless it is a statutory bar, a rejection based on a publication may be overcome by a showing that it was published either by applicant himself/herself on his/her behalf. MPEP § 715.01(c). The level of disclosure required within a reference to make it an "enabling disclosure" is the same no matter what type of prior art is at issue. It does not matter whether the prior art reference is a U.S. patent, foreign

patent, a printed publication or other. Cf. MPEP § 2121. "In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'..." *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). MPEP § 2121.01. As to answer (B), 35 U.S.C. 132 states that "[n]o amendment shall introduce new matter into the disclosure of the invention." As to (C), statutory bars of 35 USC 102(b) are applicable even though public use is by a third party. MPEP § 2133.03(e)(7). The statutory bar would apply to the modification by Ajax to use the windshield wiper device on trucks. As to (E), it is not necessary that the applicant be aware of the public use by the third party Ajax. As to (D), Chris would be barred by the public use of the truck embodiment by Ajax on September 1, 1998 as the C-I-P would not receive the benefit of the earlier filing date with respect to the truck embodiment since the original disclosure did not include the truck embodiment.

Petitioner argues that none of the answers is correct and answer (B) is the best among the five incorrect answers. Petitioner does not argue that answer (C) is incorrect. Petitioner argues that (B) is a better answer than (C) because Chris could argue that the breadth of language used in the disclosure covered the species of trucks by the genus of cars.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that answer (B) is correct because the difference would have been obvious to a skilled artisan, the question specifically states that there is no basis in the application supporting a claim directed to the embodiment for trucks. Obviousness is not an issue in written description requirements. Knowledge and inherency are issues but the fact pattern does not give any information on these issues. The fact pattern clearly states that the requirements of 35 U.S.C. 112, first paragraph, are not met for the claims directed to a truck. Accordingly, new matter will prevent Chris from adding the truck claim in the application, rendering the statement in answer (B) incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 28 reads as follows:

28. Which of the following is true?

(A) On appeal of a rejection of ten claims to the Board of Patent Appeals and Interferences, each appealed claim stands or falls separately as a result of appellant pointing out differences in what the claims cover.

(B) The 2-month period for filing a petition mentioned in 37 CFR 1.181(f) is extendable under 37 CFR 1.136(a).

(C) An examiner may enter a new ground of rejection in the examiner's answer to an applicant's appeal brief.

(D) After filing a notice of appeal, an applicant is estopped from further prosecuting the same claims in a continuation application.

(E) When desiring to claim foreign priority, the oath or declaration in a reissue application must claim foreign priority even though the priority claim was made in the original patent.

The model answer is choice (E).

Selection (E) is correct. See MPEP 1414 Content of Reissue Oath/Declaration and 37 CFR 1.175(a) which states that reissue oaths/declarations must meet the requirements of 37 CFR 1.63, including 1.63(c) relating to a claim for foreign priority. As to (A), 37 CFR 1.192(c)(7) requires appellant to state that the claims do not stand or fall together. Appellant must present appropriate argument under 37 CFR 1.192(c)(8) why each claim is separately patentable. Merely pointing out differences in what the claims cover is not argument why the claims are separately patentable. MPEP 1206, pages 1200-8 and 9. As to (B), see MPEP 1002 and the sentence bridging pages 1000-2 and 1000-3. As to (C), 37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. As to (D), continuation may be filed during pendency of parent.

Petitioner argues that answer (A) is correct. Petitioner argues that answer (A) is correct because separate argument alone is sufficient to preclude appealed claims rising or falling together.

Petitioner's argument has been fully considered but is not persuasive. As to answer (A), that answer states each appealed claim stands or falls separately as a result of appellant pointing out

differences in what the claims cover. This answer states that it is sufficient to point out differences to have claims stand or fall separately and the answer is silent on argument of each claim. As shown in the model answer, this is not sufficient, rendering answer (A) incorrect. The statement in answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 33 reads as follows:

33. A claim limitation reads "having 10 to 20 grams of iron, preferably 13-18 grams of iron." The specification preceding the claim supports not only the limitation, but also the broader amounts of iron. Which of the following statements is correct?

- (A) The limitation may be indefinite.
- (B) Since the limitation properly sets forth outer limits, it is definite.
- (C) As long as the limitation is supported in the written description, it is proper.
- (D) The limitation is definite since the limitation sets forth a preferred range.
- (E) The applicant, having set forth a limitation in the claim, i.e., a range of 10 to 20 grams, is precluded by the doctrine of equivalents from expanding the claim coverage beyond the 10 to 20 grams of iron.

The model answer is choice (A).

(A) is the most correct answer. MPEP § 2173.05, part (c) indicates that a preferred narrower range set forth within a broader range may render the claim indefinite if the boundaries of the claim are not discernable. (B), (C) and (D) are incorrect. MPEP § 2173.05(c), part (I) indicates that reciting in a single claim both a broad range and a preferred narrower range within the broad range may render the claim indefinite. (E) is incorrect. The doctrine of equivalents operates to expand claim coverage beyond the literal scope of the claim language.

Petitioner argues that MPEP 2173.05(c) says that use of a narrower range may, but not must, render a claim indefinite. Petitioner concludes that so long as the specification presents the claimed subject matter in a clear and enabling fashion, consistent with 35 U.S.C. 112, a claim meets the requirements of 35 U.S.C. 112.

Petitioner's argument has been fully considered but is not persuasive. A specification meeting the requirements of 35 USC 112, first paragraph, does not alleviate claim rejections under 35 U.S.C. 112, second paragraph. Accordingly, the claim is indefinite because it is unclear which range is being claimed. The statement in answer (A) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 44 reads as follows:

44. Which of the following statements best correctly describes current PTO practice and procedure?

(A) Where a patent discloses subject matter being claimed in an application undergoing examination, if the patent's designation of inventorship differs from that of the application, then the patent's designation of inventorship does not raise a presumption of inventorship regarding the subject matter disclosed but not claimed in the patent so as to justify a rejection under 35 U.S.C. § 102(f).

(B) The fact that a claim recites various components, all of which can be argumentatively assumed to be old, provides a proper basis for a rejection under 35 U.S.C. § 102(f).

(C) A person can be an inventor without having contributed to the conception of the invention.

(D) In arriving at conception, an inventor may not consider and adopt ideas and materials derived from other sources such as an employee or hired consultant.

(E) It is essential for the inventor to be personally involved in reducing the invention to actual practice.

The model answer is choice (A).

(A) is the most correct answer. See MPEP § 2137, p.2100-89. (B) is incorrect. The mere fact that the claim recites components, all of which can be argumentatively assumed to be old, does not provide a basis for rejection under 35 U.S.C. § 102(f). *Ex parte Billottet*, 192 USPQ 413, 415 (Bd. App. 1976); MPEP§ 2137. (C) is incorrect. One must contribute to the conception to be an inventor. *In re Hardee*, 223 USPQ 1122, 1123 (Comm'r Pat. 1984). Unless a person contributes

to the conception of the invention, the person cannot be an inventor. *Fiers v. Revel*, 984 F.2d 1164, 1168, 25 USPQ2d 1601, 1604-05 (Fed. Cir. 1993); MPEP § 2137.01 (section styled "An Inventor Must Contribute To The Conception of the Invention"). (D) is incorrect. An inventor may consider and adopt suggestions from many sources. *Morse v. Porter*, 155 USPQ 280, 283 (Bd. Pat. Inter. 1965); *New England Braiding Co. v. A.W. Cheterton Co.*, 970 F.2d 878, 883, 23 USPQ2d 1622, 1626 (Fed. Cir. 1992); MPEP § 2137.01 (section styled "As Long As The Inventor Maintains Intellectual Domination Over Making The Invention, Ideas, Suggestions, And Materials May Be Adopted From Others"). (E) is incorrect. *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982) ("there is no requirement that the inventor be the one to reduce the invention to practice so long as the reduction to practice was done on his behalf"); MPEP § 2137.01 (section styled "The Inventor Is Not Required To Reduce The Invention To Practice").

Petitioner argues that answer (D) is also correct. Petitioner contends that answer (D) suggests that conception was by someone other than the applicant, precluded by 35 USC 102(f).

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that answer (D) suggests that conception was by someone other than the applicant, precluded by 35 USC 102(f), the answer (D) specifically states that in arriving at conception, an inventor may not consider and adopt ideas and materials derived from other sources such as an employee or hired consultant. As explained in the instructions, do not assume any additional facts not presented in the questions. The answer specifies that the applicant performed the conception. There is no need to assume otherwise. Furthermore, it is certainly the case that, for example, applicant may consider and adopt well known scientific principles, such as Newton's laws of motion, in arriving at conception. Accordingly, the statement in answer (D) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 48 reads as follows:

48. Which of the following statements regarding 35 U.S.C. § 103 is most correct?

- (A) PTO classification of prior art references used to reject a claim under 35 U.S.C. § 103, and the similarities and differences in structure and function carry equal weight as evidence of whether the references are analogous or non-analogous.
- (B) The question of obviousness under 35 U.S.C. § 103 is resolved by determining whether the differences between the prior art and the claims would have been obvious.
- (C) Obviousness of an invention can be properly determined by identifying the "gist" of the invention, even where the "gist" does not take into regard an express limitation in the claims.
- (D) In delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification.
- (E) Obviousness can be predicated on what is not known at the time an invention is made, where the inherency of the feature is later established.

The model answer is choice (D).

(D) is the most correct answer as per 35 U.S.C. § 103(a); *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977) ("In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question...but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification..."); MPEP 2141.02 (section styled, "Disclosed Inherent Properties Are Part of 'As A Whole' Inquiry"). (A) is incorrect. MPEP 2141.01(a). PTO classification is some evidence of analogy/non-analogy, but structure and function carry more weight.

In re Ellis, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973).

(B) is incorrect. MPEP 2141.02. The question under 35 U.S.C. § 103 is whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983).

(C) is incorrect. MPEP 2141.02 (section styled, "Distilling The Invention Down To a 'Gist' or 'Thrust' Of An Invention Disregards 'As A Whole' Requirement"). *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052 (1987) (district court improperly distilled claims down to a one word solution to a problem).

(E) is incorrect. As stated in MPEP 2141.02 (section styled, "Disclosed Inherent Properties Are Part Of 'As A Whole' Inquiry"), "Obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established. *In re Rijckaert*, 9 F.2d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993)."

Petitioner argues that (B) is correct. Petitioner contends that answer (B) is correct because it is part of the *Graham v. Deere* factual inquiry which pertains to the claimed rather than the disclosed subject matter.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that answer (B) is correct although incomplete because it is part of the *Graham v. Deere* factual inquiry, answer (B) states "The question of obviousness under 35 U.S.C. § 103 is resolved by determining whether the differences between the prior art and the claims would have been obvious." As petitioner correctly notes, the differences form a part of the *Graham v. Deere* inquiry and the inquiry goes only to the claimed subject matter. Answer (B) states that it resolves, i.e. answers the entire inquiry, which is incorrect. The phrase "the invention as a whole" in *Graham v. Deere* refers to the claimed and not the disclosed subject matter. Petitioner's argument suggests the opposite, which is not the case. Answer (B) does not analyze the claimed invention as a whole, but merely as an aggregation of its parts. Accordingly, answer (D) is correct and answer (B) is incorrect. No error in grading has been shown.

Petitioner's request for credit on this question is denied.

The regrade of the petitioner's examination has been conducted fairly and without discrimination pursuant to a uniform standard using the PTO's model answers. See *Worley v. United States Patent and Trademark Office*, No. 99-1469, slip op. at 4 (D.D.C. Nov. 8, 2000) (The court held that the PTO's Model Answers are a uniform standard. "[S]ince all exams are graded in reference to [the Model Answers], use of the Model Answers fosters uniformity in grading and preclude[s] unfair and individually discriminatory grading." *Id.*, slip opinion at 5. The court concluded that "the decision of the Commissioner of the USPTO not to regrade Mr.

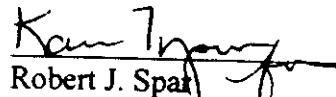
Worley's examination answers as correct when the answers did not conform with the USPTO's Model Answers was not arbitrary and capricious." *Id.*, slip opinion at 5-6.)

ORDER

For the reasons given above, no point has been added to petitioner's score on the Examination. Therefore, petitioner's score remains 67. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.


Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy